

Serial No.: 10/563,660
Docket No.: 09792909-6521
Amendment dated March 4, 2009
Reply to the Office Action of December 4, 2008

REMARKS

A. Introduction

Claims 1-10 were pending and under consideration in the application.

In the Office Action of December 4, 2008 ("the Office Action"), claims 1-10 were rejected as obvious.

Without conceding to the merits of the rejection, independent claims 1 and 4 have been amended to clarify an aspect of the present general inventive concept, and claims 11-16 have been added. No new matter is presented.

Reconsideration and allowance of the pending claims are requested in view of the following remarks.

B. Rejection under 35 USC §103

Claims 1, 2, 4, and 5 were rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent Publication No. 2004/0001134 to Nakazawa in view of U.S. Patent Publication No. 2002/0097290 to Koitabashi. Applicant traverses these rejections for at least the following reasons.

First, Independent claims 1 and 4 recite, *inter alia*, "an ink solvent containing water." Nakazawa is limited to an oil-based ink and specifically rejects aqueous inks to avoid problems associated with aqueous inks, i.e., to avoid "cockling of paper due to ink absorption, as with aqueous ink, does not occur, and there are fewer constraints on the recording medium." See Nakazawa, para. 55. Thus, Nakazawa discloses exactly the opposite of the present general inventive concept and requires a completely different approach to the ink employed.

Second, the Examiner argues that the recitation of "a recording material" is "merely nonfunctional descriptive material, not related to the actual recording method and does not carry patentable weight." See the Office Action, page 7. However, the use of a recording material is directly related to a method of recording for at least the reason that

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the recording material is absolutely necessary for the method of recording to function.
Thus, reconsideration and examination of all the recited elements are requested.

Third, none of the art of record teaches ink absorption amounts as recited. The claims recite a recording material having an ink absorption amount in 100 msec of 15 mL/m^2 or more, between 15 and 99 mL/m^2 , between 15 and 40 mL/m^2 , and between 18 and 40 mL/m^2 . While the Examiner hypothesizes that Nakazawa could be used with a recording material with any of these ink absorption amounts, the hypothesis is inappropriate given that there is no disclosure or suggestion within Nakazawa itself. Koitabashi fails to remedy the Nakazawa deficiency because Koitabashi is limited to an absorption amount in 100mS of 100 mL/m^2 or more, which is not the same as “100 msec of 15 mL/m^2 or more.” Rather, Koitabashi specifically excludes the range of 15 mL/m^2 to 99 mL/m^2 . Further, Koitabashi teaches away from the other recited absorption amounts, e.g., between 15 and 99 mL/m^2 , between 15 and 40 mL/m^2 , and between 18 and 40 mL/m^2 . Particularly, Koitabashi states that “[i]f it is in this range [of 100mS of 100 mL/m^2 or more], even in the case of making multi-printings, occurrences of bleeding, repelling, and beadings can be prevented.” See Koitabashi, para. 61. Thus, Koitabashi fails to disclose or suggest all of the recited absorption amounts, and teaches away from the recited absorption amounts so as to prevent “bleeding, repelling, and beadings.” *Id.*

Fourth, Nakazawa cannot be combined with Koitabashi because Nakazawa is limited to an oil-based ink and Koitabashi is limited to an aqueous ink. As pointed out above, Nakazawa specifically rejects aqueous inks to avoid problems associated with aqueous inks, i.e., to avoid “cockling of paper due to ink absorption, as with aqueous ink, does not occur, and there are fewer constraints on the recording medium.” See Nakazawa, para. 55. Thus, Nakazawa specifically teaches away from Koitabashi by requiring a completely contradictory approach to the ink employed by either printing device, and therefore one of ordinary skill in the art would not have been motivated to combine these references, and no expectation of success in combining these references exist. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (References are not properly combinable or modifiable if their intended function is destroyed).

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Accordingly, independent claims 1 and 4 are patentable over the references and withdrawal of these rejections and allowance of these claims are earnestly solicited. Likewise, claims 2, 3, and 5-16 depend from either independent claims 1 or 4 and include all of the limitations of independent claims 1 and 4. Accordingly, dependent claims 2, 3, and 5-16 are also allowable over these references for at least the same reasons discussed above with respect to claims 1 and 4.

C. Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,
SONNENSCHN NATH & ROSENTHAL LLP

By /Adam C. Rehm/
Adam C. Rehm, Reg. No. 54,797
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
816-460-2542 (telephone)
816-531-7545 (facsimile)

ATTORNEYS FOR APPLICANT